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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL MILLS

Appeal 2008-0342
Application 09/728,395
Technology Center 3700

Decided: August 7, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and JOHN C. KERINS, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Paul Mills (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-13. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellant's claimed invention is directed to a packaging system for packaging a plurality of articles into packs and collecting together a plurality of packs into a packaged unit (Specification 1). Appellant's system is provided with a plurality of components connected to a data bus by respective connecting means and a control means for controlling and coordinating the components by sending appropriately addressed data bus commands via the data bus to each of the connected components using a common computer protocol. Each of the connecting means includes means to translate data bus commands appropriate to its respective component into a command protocol that is read by the connected component. (Specification 2-3.) Consequently, Appellant's system permits a single controller using a single command protocol to control connected components that use different command protocols (Specification 2, 3).

Independent claim 1 is illustrative of the claimed invention and reads as follows:

> 1. A packaging system for packaging a plurality of individual articles into packs and for collecting together a plurality of packs into a packaged unit, the system including
>
> a first part where the individual articles are marked utilising [*sic*: utilizing] a first marking means,
>
> a second part where the packs are marked utilising [*sic*: utilizing] a second marking means, and
>
> a third part where the packaged unit is marked utilising [*sic*: utilizing] a third marking means, and

> the first part including packing means for packing the articles into packs and first conveying means for moving the packs from the first part to the second part, and
>
> the second part including second conveying means for conveying the packs from the second to the third system part, and
>
> the third part including means to collect the plurality of packs into a packaging unit, wherein each of the first, second and third marking means, and the means for collecting[1] the plurality of packs into a packaged unit are connected to a data bus by respective connecting means,
>
> there being a control means also connected to the data bus, the control means sending appropriately addressed data bus commands on the data bus to each of the connected components, the data bus commands all using a common computer protocol, and each of the connecting means of the connected components including means to translate data bus commands appropriate to that component into a command protocol which is read by the connected component which responds by performing a productive function, whereby the control means is able to control each of the connected components independent of command protocols recognised [sic: recognized] by the connected components.

The Rejection

Appellant seeks review of the Examiner's rejections of claims 1, 2, and 6 under 35 U.S.C. § 102(e) as anticipated by Komiya (US 6,155,025,

[1] The "means to collect" should be changed to "means for collecting" for consistency and to provide clear antecedent basis for "means for collecting."

issued December 5, 2000) and claims 3-5 and 7-13 under 35 U.S.C. § 103(a) as unpatentable over Komiya.

The Examiner provides reasoning in support of the rejections in the Answer, mailed December 1, 2006. Appellant presents opposing arguments in the Appeal Brief ("Appeal Br."), filed September 14, 2005, and Reply Brief ("Reply Br."), filed January 29, 2007. Appellant's counsel presented oral argument on July 9, 2008.

OPINION

This appeal focuses on the limitation in claim 1 that each of the connecting means of the connected components include means to *translate* data bus commands appropriate to that component into a command protocol that is read by the connected component, whereby the control means is able to control each of the connected components *independent of command protocols recognized by the connected components*.[2] In particular, the dispositive issue is whether Komiya inherently includes such means to translate in the connection between the various component computers and the main controller (information management computer 66), so as to anticipate the subject matter of claim 1.

Komiya teaches an article packaging system for labeling and packaging articles (photographic film cartridges 12) into packs (small boxes 30) (Komiya, col. 9, ll. 19-21 and 63-67). The small boxes 30 are printed

[2] We interpret the language "there being a control means also connected to the data bus" in claim 1 as a statement that the claimed system includes the recited control means connected to the data bus.

with indicia 38 (Komiya, col. 10, ll. 9-12). A plurality of small boxes 30 are collected and packed in corrugated boxes (Komiya, col. 11, ll. 14-25).

The various operations of the machines for making the cartridges and cartridge cases and for packaging the cartridges into small boxes and corrugated boxes are managed by a molding machine management computer 68, an assembling machine management computer 70, a winding machine management computer 72, an outer shipping packaging machine management computer 84, and a packing machine management computer 86 (Komiya, col. 11, ll. 26-45). A production information management computer 66 manages the operations of all of these computers (Komiya, col. 12, ll. 35-41). Komiya is silent as to whether the various computers and machines operate using a common protocol or different protocols.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the

> questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In re Oelrich, 666 F.2d 578, 581 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)).

In rejecting claims 1, 2, and 6 as anticipated by Komiya, the Examiner concedes that Komiya does not specifically refer to the data bus that transmits signals from production information management computer 66 to the peripheral units and translation of commands from the controller (computer 66) to the peripheral units (Answer 4). Stated differently, the Examiner finds that Komiya does not expressly teach a data bus and connection means including means to translate data bus commands into a protocol that can be read by the connected component. Nevertheless, the Examiner contends that Komiya anticipates the subject matter of claim 1 because the data bus for connecting all elements to the controller (computer 66) and a means for translating data bus commands are inherent features of Komiya's system (Answer 4 and 6). The Examiner reasons that if Komiya did not possess these features, the component computers of Komiya's system would not be able to communicate with one another (Answer 7).

Appellant argues that connecting means including means to translate data bus commands into a command protocol that can be read by the connected component is not an inherent feature of Komiya's system because Komiya could operate without this feature. For example, according to Appellant, rather than relying on such translation means, Komiya's system could either "(1) rely on equipment being replaced by equipment which operates according to the same protocol as the replaced equipment or (2) rely on reprogramming of the computer controller" (Appeal Br. 7). In

support of this argument, Appellant relies on a declaration under 37 C.F.R. § 1.132 by Appellant Paul Mills (the "Mills Declaration") filed June 1, 2004. In particular, Appellant points out that

> [t]here is no reason to assume that each component has a "respective connecting means" with a means to translate the data bus commands to commands appropriate to the specific device. Instead, it is more likely to assume Komiya envisaged that if an item of equipment were to be replaced, it would be replaced by an item which operates according to the same protocol (as the one being replaced) or else, that the computer controller is reprogrammed (e.g., to use a new driver for the new component) to cope with such a new item of equipment.

Mills Declaration, ¶ 10.

Appellant offers two very plausible alternatives as to how the production information management computer 66 of Komiya's system could communicate with the peripheral units without having connecting means including means to translate data bus commands into a command protocol that is read by the connected component. In so doing, Appellant persuades us that the Examiner erred in concluding that Komiya inherently possesses connection means including means to translate data bus commands appropriate to that component into a command protocol that is read by the connected component, whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components, as called for in independent claim 1. Therefore, we cannot sustain the rejection of claim 1, and claims 2 and 6 depending from claim 1, as anticipated by Komiya.

The Examiner's rejection of claims 3-5 and 7-13, which depend from claim 1, as unpatentable over Komiya is grounded in part on the Examiner's flawed determination that Komiya inherently possesses connection means including means to translate data bus commands appropriate to that component into a command protocol that is read by the connected component, whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components, as called for in claim 1. Thus, we are also constrained to reverse the rejection of claims 3-5 and 7-13 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1-13 is reversed.

REVERSED

vsh

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